



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,133	03/27/2001	Randall A. Russell	RUS001-461611.1	3821

23444 7590 01/27/2005

ANDREWS & KURTH, L.L.P.
600 TRAVIS, SUITE 4200
HOUSTON, TX 77002

EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,133

Applicant(s)

RUSSELL, RANDALL A.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

This action is in response to the Applicant's amendment filed on October 26, 2004. Claim 14 has been canceled. New claims 15-18 have been entered. Claims 1-13 and 15-18 are pending and will be considered for examination. The amendments to claims 2 and 14 are sufficient to overcome the rejection under 35 USC 112, second paragraph. This rejection is hereby withdrawn.

Drawings

Figures 3 and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. These figures show a computer system with a database and software components. Furthermore, the Applicant admits that Figures 3 and 4 are prior art (see specification page 13, lines 16-19). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-6, 8-10, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims invoke 112, sixth paragraph by using means plus function language; however, the specification does not disclose any structure for performing the functional language. *"If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994).*

Claim 3 recites the limitation "means for verifying..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 4 recites the limitations "means for monitoring..." and "means for notifying..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 5 recites the limitations "means for determining..." and "means for...electronic access..." However, the specification does not disclose any structure

Art Unit: 3625

used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 6 recites the limitations "means for monitoring..." and "means for notifying..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 8 recites the limitations "means for determining..." and "means for...electronic access..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 9, recites the limitation "means for notifying a parent..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim 10, recites the limitation "means for selecting student accounts..." However, the specification does not disclose any structure used for the recited functional language. For examination purposes, the Examiner will assume that the structure is a computer.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lotvin et al. (US 5,907,831) hereinafter referred to as Lotvin.

Referring to claim 1, Lotvin teaches a commerce system comprising: an electronic network based central controller trustee computer which is accessible by students, parents, and vendors via an electronic network (Abstract; column 1, lines 40-45, lines 56-62), said central controller trustee computer including software having, a commerce database module by which a parent has previously established a student account with pertinent information about the student and with information as to how the account is to be funded from a third party financial institution by said parent and with information as to spending restrictions with a vendor which are imposed on said account by said parent (column 5, line 64 – column 6, line 5; column 8, lines 42-60; column 9, lines 22-30; column 14, lines 9-27), means for transferring funds from said third party financial institution into said student account (column 5, line 64 – column 6, line 5). The Applicant's specification discloses that the means for transferring includes, but not limited to, cash, check, ACH debit, wire transfer, credit or debit card (see specification page 5, lines 18-20). Lotvin also teaches an input device designed and arranged to accept manually input information including student identification number, student password and purchase amount information and to transfer said keyed-in information to said commerce database module (column 3, lines 58-67; column 7, lines 30-44). Finally, Lotvin teaches means for transferring funds from said student account to a vendor account when said student causes said manually input information to be transferred (column 13, line 54 – column 14, line 8). The Applicant's specification

Art Unit: 3625

discloses that the means for transferring includes, but not limited to, cash, check, ACH debit, wire transfer, credit or debit card (see specification page 5, lines 18-20). Lotvin does not teach that his commerce system is a school commerce system or that the central controller computer is accessible by a school trustee. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The structural elements of the Applicant's system would be the same regardless of the type of commerce system or who was allowed access the system. The differences between the Applicant's system and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have any type of commerce system that was accessible by anyone because these features do not functionally relate to the elements of the claimed system and because the subjective interpretation of these features does not patentably distinguish the claimed invention.

Referring to claim 2, Lotvin teaches that the student account is a common student account for a plurality of student of a parent (column 7, lines 48-53).

Referring to claim 3, Lotvin teaches means for verifying that there are no restrictions on said student account that would prohibit a transaction with said vendor (column 13, lines 37-53; column 14, lines 9-27).

Referring to claim 4, Lotvin does not teach means for monitoring a student account to determine if a minimum balance is present, or means for notifying a parent if the minimum balance is not present in the account. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the system of Lotvin. One of ordinary skill in the art would have been motivated to do so in order to allow the parent to have greater control over the child's account.

Referring to claim 5, Lotvin teaches means for determining a balance and transaction history in said account, and means for a parent to have electronic access to said balance and said transaction history in said account (column 8, line 61 – column 9, line 20).

Referring to claim 6, Lotvin teaches means for monitoring said account for abnormal account activity, and means for notifying said parent of said abnormal account activity (column 5, lines 20-28; column 15, lines 12-15).

Referring to claim 7, Lotvin teaches means for transferring funds from said vendor account to a third party vendor financial institution (column 13, line 54 – column 14, line 8). The Applicant's specification discloses that the means for transferring includes, but not limited to, cash, check, ACH debit, wire transfer, credit or debit card (see specification page 5, lines 18-20).

Referring to claim 8, Lotvin does not disclose means for determining a vendor account balance and transaction history, or means for the vendor to have electronic access to said vendor account balance and transaction history. However, it would have

been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the system of Lotvin. One of ordinary skill in the art would have been motivated to do so in order to allow a vendor to control and view its account online.

Referring to claims 9-11, 13, and 15-17, Lotvin teaches means for notifying a parent of a student who has a student account of information about the student's data (column 8, line 61 – column 9, line 20). Lotvin does not disclose that the data is school events of interest. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The structure of notifying would be the same regardless of what information the data represented. The difference between the Applicant's data and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the invention of Lotvin because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 12, Lotvin teaches means for providing access to information in said database (column 3, lines 58-66). Lotvin does not teach trustee of a school or

Art Unit: 3625

information about a particular school. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The structure of providing would be the same regardless of what information the database contained or who accessed the database. The differences between the content of the Applicant's data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the database of Lotvin or to allow anyone access to the database because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 18, this claim is similar to claims 1-13 and 15-17 and therefore the rejection of this claim is the same as presented in the rejection of claims 1-13 and 15-17.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3625

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

January 21, 2005


Y. G. Garg
Primary Examiner